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TRANSMITTAL FORM 	Application Number	09/445,043	
	Filing Date	March 20, 2000	
	First Named Inventor	Baird-Smith et al.	
	Art Unit	3727	
	Examiner Name	Robin Annette Hylton	
Total Number of Pages in This Submission	36	Attorney Docket Number	350013-65

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Date	March 23, 2006	Reg. No.	34,950

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☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

Complete if Known

Application Number	09/445,043
Filing Date	March 20, 2000
First Named Inventor	Ian Baird-Smith
Examiner Name	R. Hylton
Art Unit	3727
Attorney Docket No.	350013-65/US

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Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
- 20 or HP =	x	=		Fee (\$)

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	x	=	

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

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Signature

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Barbara A. Wrigley

Date March 23, 2006

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Serial No. 09/445,043

Appeal Brief

Page 1 of 34

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before The Board of Patent Appeals and Interferences

Applicant: Ian Baird Smith et al.

Serial No.: 09/445,043

Filing Date: March 20, 2000

Title: APPARATUS AND METHOD FOR
CLOSING OFF THE OPEN END
OF A CONTAINER WITH A
REMOVABLE FLEXIBLE
MEMBRANE COVERED BY A
RIGID CAP

Group Art Unit: 3727

Examiner: Robin Annette Hylton

Docket No: 350013-000065

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[Signature] 3/23/06

APPELLANT'S APPEAL BRIEF

Dear Sir:

In response to the Office communication dated January 9, 2006, Appellant submits this Appeal Brief to appeal the final rejections dated August 24, 2005 by Examiner Robin Annette Hylton.

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(1) REAL PARTY IN INTEREST

The present application was assigned to Lawson Mardon Sutton Ltd., a corporation organized and existing under the laws of the United Kingdom.

(2) RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present case.

(3) STATUS OF CLAIMS

Claims 1, 3, 4, 6, 8-11, and 13 are pending and are herein appealed. Claims 14-22 have been withdrawn. Claims 2, 5, 7, and 12 have been cancelled.

Claims 1, 3, 4, 6, 8-11, and 13 have been rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Hiroshi, Japan Application 06219464.

Claims 1, 3, 4, 6, 8-11, and 13 have been rejected pursuant to 35 U.S.C. § 112 ¶ 1.¹

Claims 1, 3, 4, 6, 8-11, and 13 have been rejected pursuant to 35 U.S.C. § 112 ¶ 2.

¹ It is unclear from the papers of the prosecution whether claims 1, 3, 4, 6, 8-11, and 13 continue to be rejected pursuant to 35 U.S.C. § 112 ¶¶ 1 and 2. In the Office Action dated December 16, 2004, such rejections were asserted by the Office. Appellant's Amendment and Response filed March 16, 2005 traversed the rejections. In the subsequent Office Action, made final, the Office did not address the rejections pursuant to 35 U.S.C. § 112 ¶¶ 1 and 2 nor acknowledge that the rejections had been overcome. Because the Examiner asserted an objection to the drawings that is directly related to the §112 ¶1 and 2 rejections, out of an abundance of caution, Appellant addresses these rejections and the objection to the drawings *infra*.

(4) STATUS OF AMENDMENTS

No amendments have been filed that are presently pending decision.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The present invention generally relates to a container assembly comprising an open-ended container and a closure for the open-ended container, the closure comprising a flexible membrane. The various claims are directed toward the assembly wherein the general improvements over the prior art include, *inter alia*, providing an easy-open end to the container assembly permitting obtaining the contents of the can without the use of an opening device.

More specifically, Appellant's claim 1 recites an assembly comprising a closure for an open-ended container, and an open-ended container, the container assembly comprising: (i) a flexible membrane for closing the open end of the container (*see* Specification at ¶¶ 0014, 0034, 0043; Figs. 1 and 2)²; (ii) an adhesive seal between the flexible membrane and the container (*see* Specification at ¶¶ 0015, 0040-42; Figs. 1 and 2); (iii) a rigid cap having a resiliently deformable member juxtaposed to the flexible membrane such that when the cap is in use, the flexible membrane is pressed against the container in the vicinity of the seal, thereby reinforcing the seal sufficiently to withstand high pressures which are generated from cooking the contents of the container (*see* Specification at ¶¶ 0016-17; 0050-51; Figs. 1 and 2); (iv) the rigid cap further having a first cam and follower pair, which when in use is engaged with a second cam and follower pair located on the container neck, relative movement between the first and second cam and follower pairs in a predetermined direction causes the rigid cap and the

² All citations to the specification are made to U.S. Publication 20020125249 by paragraph number where appropriate.

container neck to approach one another, thereby increasing the pressure exerted by the resiliently deformable member on the flexible membrane (*see* Specification at ¶¶ 0025; 0044; 0046; Figs. 1 and 2); and (v) the rigid cap further having a laminar member and an annular skirt, the skirt extending downwardly from the laminar member, and the second cam and follower pair is secured on an upper wall of the skirt, wherein the laminar member is spaced from the flexible membrane by a distance less than the maximum possible extension of the flexible membrane towards the laminar member (*see* Specification at ¶¶ 0045; 0048; 0053; Figs. 1 and 2).

(6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Office rejected claims 1, 3, 4, 6, 8-11, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Hiroshi (Japan Application 06219464). In making this obviousness rejection, has the Office established a *prima facie* case of obviousness?

The Office rejected claims 1, 3, 4, 6, 8-11, and 13 pursuant to 35 U.S.C. § 112 ¶ 1 as failing to comply with the written description requirement. In making this rejection, has the Office established that the specification fails to satisfy the written description requirement?

The Office rejected claims 1, 3, 4, 6, 8-11, and 13 pursuant to 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In making this rejection, has the Office established that the claims are indefinite?

(7) ARGUMENT

A. *History of Prosecution*

Appellant filed this United States application containing claims 1-21 on March 20, 2000 as a national stage filing of international application number PCT/IB98/00825 dated May 28, 1998. Before the first Office Action on the merits, Appellant was required to elect claims for prosecution pursuant to a restriction requirement, and Appellant withdrew claims 19-21 from consideration without traverse. The first substantive Office Action addressing the merits of patentability was issued February 28, 2001, wherein the Office rejected pending claims 1-7 and 9-18 pursuant to 35 U.S.C. §§ 102(b); claims 8 and 11 pursuant to 35 U.S.C. § 103(a); and claim 7 pursuant to 35 U.S.C. § 112 ¶ 2.

On July 30, 2001, Appellant responded to the Office Action, amending the title, drawings, and specification, and amending claims 1, 3, 4, 6, 8-14, and 16-18. New claim 19 was added,³ and claims 2, 5, and 7 were cancelled. Appellant additionally presented detailed arguments regarding the differences between the invention and the cited references.

On July 31, 2001, Appellant submitted a supplemental amendment in which “new” claim 19 was further amended.

³ It appears that the designation of the new claim as “19” was in error, as a claim 19 had been previously presented for prosecution but subsequently withdrawn. This claim should have been designated “22”. Curiously, it appears this new claim was neglected until July 5, 2002, in which it was addressed for the first time in the Office Action of that date.

On January 14, 2002, the Office issued an Office Action made final, rejecting claims 1, 3, 4, 6, and 8-18 pursuant to 35 U.S.C. § 103(a) and claims 12 and 13 pursuant to 35 U.S.C. § 112 ¶ 2.

On February 27, 2002, Appellant responded to the Office Action, amending claims 1, 4, 12, and 14.

On March 7, 2002, the Office issued an Advisory Action, noting that the claim amendments submitted February 27, 2002 raised new issues requiring further search and/or consideration, as well as potentially introducing new matter.

On April 15, 2002, Appellant filed a Request for Continued Prosecution Application.

On July 5, 2002, the Office issued an Office Action, rejecting claims 1, 3, 4, 5, 8-18, and 22⁴ pursuant to 35 U.S.C. § 103(a), and rejecting claims 1, 3, 4, 6, 8-18, and 22 pursuant to 35 U.S.C. § 112 ¶¶ 1 and 2.

On October 7, 2002, Appellant responded to the Office Action, amending the title and specification, and amending claims 1, 4, and 12. Appellant additionally presented detailed arguments regarding the differences between the invention and the cited references.

⁴ Formally “new” claim 19.

On January 29, 2003, the Office issued an Office Action, rejecting claims 1, 3, 4, 6, 8-18, and 22 pursuant to 35 U.S.C. § 112 ¶¶ 1 and 2, and rejecting claims 1, 3, 4, 6, and 8-18 pursuant to 35 U.S.C. § 103(a).

On July 29, 2003, Appellant responded to the Office Action, canceling claim 12 and amending claims 1, 3, 4, 6, 8 -11, and 13-17. Appellant additionally presented detailed arguments regarding the differences between the invention and the cited references.

On October 21, 2003, the Office issued an Office Action made final, again rejecting claims 1, 3, 4, 6, 8-11, 13-18, and 22 pursuant to 35 U.S.C. § 112 ¶ 2, and rejecting claims 1, 3, 4, 6, 8-11, and 13-18 pursuant to 35 U.S.C. § 103(a).

On February 12, 2004, Appellant responded to the Office Action made final, amending claims 1, 3, 4, 6, 10-11, 14-15, 17-18, and 22. Appellant additionally presented detailed arguments regarding the differences between the invention and the cited references.

On March 16, 2004, the Office issued an Advisory Action, noting that the claim amendments submitted February 12, 2004 raised new issues requiring further consideration and or search.

On April 19, 2004, Appellant filed a Request for Continued Examination.

On July 15, 2004, the Office again stated the claims were subject to further restriction, requiring election for prosecution purposes between Group I, consisting of claims 1, 3, 4, 6, 8-11, and 13, and Group II, consisting of claims 14-18, and 22.

On August 16, 2004, Appellant responded to the election/restriction requirement and elected Group I with traverse, further arguing and requesting reconsideration and withdrawal of the election/restriction requirement as unnecessary in light of the previous prosecution and search conducted.

On December 16, 2004, the Office issued an Office Action making the restriction final and rejecting claims 1, 3, 4, 6, 8-11, and 13 pursuant to 35 U.S.C. § 112 ¶ 1 and 2, and further objecting to the drawings and specification. Rejections pursuant to 35 U.S.C. § 103 were not asserted in light of the section 112 rejections. The Office further noted that the lack of a rejection should not be considered to avoid the prior art of record.

On March 16, 2005, Appellant filed an amendment and response, amending the specification and amending claims 1 and 6. Appellant further provided detailed arguments regarding the differences between the invention and the prior art.

On August 24, 2005, the Office issued an Office Action made final, again rejecting claims 1, 3, 4, 6, 8, 9, and 13 pursuant to 35 U.S.C. § 103(a) and objecting to the drawings as failing to disclose the “laminar member.” Unclear in this Office Action is

whether the rejections pursuant to 35 U.S.C. § 112 ¶¶ 1 and 2, were successfully traversed.⁵

On November 10, 2005, a telephonic interview was held between the Examiner and counsel for Appellant. Regarding the objection to the drawings, Examiner asserted that the term “laminar” has the ordinary meaning of more than one layer in the closure art, requiring such illustration in the drawings or cancellation of those claim elements that rely upon such disclosure.

On December 21, 2005, Appellant filed a response, addressing the objection to the drawings, specifically regarding the Examiner’s interpretation of the term “laminar” and its effect on the drawings. Appellant additionally presented detailed arguments regarding the differences between the invention and the cited references.

On January 9, 2006, the Office issued an Advisory Action, denying Appellant’s request for reconsideration.

On January 23, 2006, Appellant filed a Notice of Appeal appealing the rejections of the Office Action made final dated August 24, 2005 as well as the rejections pursuant to 35 U.S.C. § 112 ¶¶ 1 and 2 detailed in the Office Action dated December 16, 2004. This Notice of Appeal was received by the Office on January 23, 2006.

⁵ The Examiner rejected various claims under §112 ¶1 for failing to disclose the cap having a laminar member from which the skirt depends while at the same time objecting to the drawings under Rule 1.83(a) stating that the laminar member must be shown in the drawings or canceled from the claims. In a response to Office Action filed March 16, 2005 and with ample support in the specification, Appellant amended the specification to more particularly point out that the laminar member is a circular disc having an annular skirt depending therefrom. In the Office Action dated August 24, 2005 maintained her objection.

B. *Rejection of Claims 1, 3, 4, 6, 8 -11, and 13 pursuant to 35 U.S.C. § 103(a).*

Claims 1, 3, 4, 6, 8-11, and 13 have been rejected pursuant to 35 U.S.C. § 103(a) by application of *Hiroshi*, Japan Application 06219464 (hereinafter “*Hiroshi*”).⁶ *Hiroshi* fails to teach or suggest all limitations of the claimed invention, and, therefore, cannot and does not render the present invention obvious. Appellant respectfully requests that the Office rejections pursuant to 35 U.S.C. § 103(a) be reversed and a Notice of Allowance be issued.

The present invention generally provides for an apparatus comprising a closure of an open-ended container, and an open-ended container, the container assembly comprising:

- (i) a flexible membrane for closing the open end of the container;
- (ii) an adhesive seal between the flexible membrane and the container;
- (iii) a rigid cap having a resiliently deformable member juxtaposed to the flexible membrane such that when the cap is in use, the flexible membrane is pressed against the container in the vicinity of the seal, thereby reinforcing the seal sufficiently to withstand high pressures which are generated from cooking the contents of the container;
- (iv) the rigid cap further having a first cam and follower pair, which when in use is engaged with a second cam and follower pair located on the container neck, relative movement between the first and second cam and follower pairs in a predetermined direction causes the rigid cap and the container neck to approach on another, thereby

⁶ An English translation of *Hiroshi* was filed by Appellants in response to a non-final Office Action dated February 28, 2001. Appellants filed its response on July 7, 2001. All references to paragraph numbers of *Hiroshi* in this Appeal Brief are made in reference to the English translation.

increasing the pressure exerted by the resiliently deformable member on the flexible membrane; and

(v) the rigid cap further having a laminar member and an annular skirt, the skirt extending downwardly from the laminar member, and the second cam and follower pair is secured on an upper wall of the skirt,

wherein the laminar member is spaced from the flexible membrane by a distance less than the maximum possible extension of the flexible membrane towards the laminar member.

(See Appendix, claim 1 (apparatus)). The Office asserts that the limitation of subpart (v), regarding the spacing of the laminar member in comparison to the flexible membrane, is obvious in view of *Hiroshi*. See Office Action 08/24/2005, at 2. However, this rejection is unsupported by *Hiroshi* and a *prima facie* case of obviousness has not been established because (1) impermissible reliance on Appellant's specification has occurred in light of no developed evidentiary record to support the obviousness rejection; and (2) *Hiroshi* teaches away from the claimed spacing of the laminar member and flexible membrane as such modification would render the *Hiroshi* disclosure inoperable for its intended purpose.

1. Impermissible hindsight is applied as the basis of rejection.

To establish *prima facie* obviousness, "there must be some suggestion or motivation ... to modify the reference." MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). "The teachings or suggestion . . . must . . . be found in the prior art, and not based on applicant's disclosure." *Id.*

Establishing that the claimed invention is an obvious modification of the prior art reference requires the Office to develop an evidentiary basis for the obviousness finding.

In re Lee, 277 F.3d 1338, 1345-1346, 61 USPQ2d 1430, 1435-1436 (Fed. Cir. 2002). In *Lee*, the Federal Circuit reversed a finding by the Board that an invention was obvious over the prior art because the Board failed to establish an evidentiary record on which to substantiate the finding of obviousness. The Board had held that it was not necessary to present a source of the teaching, suggestion, or motivation to combine these references or their teachings, and adopted the Examiner's obviousness rejection that the combination of two prior art references cited during prosecution "would have been obvious to one of ordinary skill in the art" without further discussion of how it was obvious. *Id.* at 1341, 1344, 61 USPQ2d at 1432, 1434. The Board erred when it further stated that "a specific hint or suggestion of motivation to combine was not required," and that "[t]he conclusion of obviousness may be made from common knowledge and common sense a person of ordinary skill in the art without any specific hint or suggestion in the particular reference." *Id.* at 1341, 61 USPQ2d at 1432. The Federal Circuit disagreed, holding that the Office must particularly mention some suggestion or motivation in the reference or how one of ordinary skill in the art would modify the teachings of the prior art. *Id.* at 1345-1346 61 USPQ2d at 1435.

Similar to the prosecution of the application in *Lee*, the Office in the instant application does not articulate with specificity how one skilled in the art might modify the teachings of *Hiroshi* as suggested by *Hiroshi*. *See Id.* at 1343, 61 USPQ2d at 1433. The Office simply stated:

Hiroshi is silent regarding the spacing between the laminar member and the flexible membrane. It would have been obvious to one of ordinary

skill at the art at the time the invention was made to make the spacing between the laminar member and the flexible membrane less than the maximum possible extension of the deformable member towards the laminar member to prevent rupture of the flexible member due to excessive pressure within the closed can.

Office Action 8/24/05, at 3. However, a detailed review of *Hiroshi* does not disclose, teach, or suggest that the distance between the laminar member and the flexible membrane is significant.

Hiroshi discloses the importance of the flexible membrane being capable of maintaining its form under high pressure (i.e. at temperatures greater than 100° C), but it does not teach or suggest that the distance of the laminar member from the flexible membrane assists in maintaining form. See *Hiroshi* at ¶ 3, 14. In contrast to the prior art, the present invention at claim one subparts (iv) and (v) recites that when the first and second cam and follower pairs on the rigid cap and container neck are fastened/tightened, the laminar member of the rigid cap increases the pressure exerted and that this juxtaposes the laminar member next to the flexible membrane by a distance less than the maximum possible extension of the flexible membrane towards the laminar member. These elements are not suggested in the prior art.

Because *Hiroshi* does not teach or disclose that the spacing between the laminar member and the flexible membrane is or should be less than the maximum possible extension of the deformable member towards the laminar member, and no other evidence is identified nor evidentiary record provided by the Office, effectively the Office improperly finds suggestion or motivation in the prior art based on the Applicant's

disclosure. *See In re Lee*, 277 F.3d at 1343-44, 61 USPQ2d 1433-1434 (where an evidentiary basis for an obviousness rejection has not been established, risk arises that basis of modification found in application). Such consideration of the Applicant's disclosure for such a purpose is improper. MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Therefore, the obviousness rejection pursuant to 35 U.S.C. § 103(a) is inappropriate.

Hence, the Office has not shown that there is a *prima facie* case of obviousness because as stated above, the prior art reference does not teach nor suggest the claimed invention, which is a container comprising various elements including a laminar member being juxtaposed against the flexible membrane. Further, one of ordinary skill in the art is not motivated to modify the prior art reference in the absence of such suggestion. Moreover, there can be no reasonable expectation of success if there is not some suggestion or motivation in the prior art. Finally, the prior art reference does not teach all the claim limitations. A rejection of obviousness cannot comprise hindsight use of the Applicant's disclosure as obviousness must be found in the prior art. Therefore, rejection pursuant to 35 U.S.C. § 103(a) is improper, and Appellant respectfully requests that the rejection be reversed and a Notice of Allowability be issued.

2. *Hiroshi* teaches away from the limitation that the laminar member is juxtaposed next to the flexible membrane by a distance less than the maximum possible extension of the flexible membrane towards the laminar member.

Hiroshi would be unusable if modified by the improvement of the present invention based upon the limitations disclosed, and therefore such limitations of *Hiroshi*

teach away from such improvement. “If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01(V) (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). In *Gordon*, the Federal Circuit reversed the Board’s determination that the claims were *prima facie* obvious because the modification of the existing device, turning it upside down, rendered the device unusable. Specifically, the claimed device was a blood filter assembly wherein the inlet and outlet for the blood were located at the bottom end of the filter assembly and a gas vent was located at the top end of the filter assembly. *See Id.* at 901, 221 USPQ at 1126. The prior art reference applied was a liquid strainer designed for removing dirt and water from gasoline, the inlet and outlet being at the top of the device and a valve located at that bottom of the device to remove collected dirt and water. *Id.* at 901-902, 221 USPQ at 1127. Further, the prior art device operated by gravity to separate the heavier particulate matter and water from the gasoline. *Id.* at 902, 221 USPQ at 1127. The Board held that the claimed invention was obvious in light of being able to rotate the prior art device 180 degrees. *Id.* The Federal Circuit reversed, finding that if the prior art was turned upside down the invention would be inoperational, as the gasoline would be trapped in the device and the water and dirt would flow through the outlet. *Id.* Hence, because the prior art device would be inoperational for its intended purpose, it did not teach or suggest the proposed modification. *Id.*

Similarly, in the present application the alleged obvious modification of *Hiroshi* would render *Hiroshi* inoperable. According to the disclosure of *Hiroshi*, an interior lid 3

formed of a plastic sheet is heat sealed to a container body 1. Over the interior lid 3 is placed an exterior lid 5, on the underside of the exterior lid being a gasket ring 6 which when the exterior lid 5 is placed on the container 1 makes contact with the edge of the interior lid 3. Notably, the space between the interior lid 3 and the exterior lid 5 is not considered significant in *Hiroshi*, as no teaching or reference is made with respect to this element in the drawings or in the specification. Additionally, the exterior lid 5 contains a series of vent holes 8. See, *Hiroshi* at ¶10 and Figure 1.

Hiroshi discloses that the outer lid 5 is put on the inner lid 3 and turned to fasten it tightly to an upper surface of the opening of the container body 1 through a screw mechanism. *Hiroshi*, ¶ 13. In a container thus covered with lids 3 and 5, in which the inner lid 3 is fastened by the outer lid 5, *when a high temperature treatment is carried out under pressure*, the inner lid 3 is prevented from peeling off. *Hiroshi*, ¶14 and [Effect], page 2 (emphasis added). Thus at the time of the high temperature treatment which occurs under pressure, both the inner lid 3 and outer lid 5 are attached, the outer lid further containing the vent holes 8. *Hiroshi*, ¶15.

As identified by *Hiroshi*, the intended use of the disclosed device is to hold packaged food, the packaging process requiring the device to be heated to a temperature that sterilizes the internal surfaces of the disclosed device. *Hiroshi*, ¶13. The Office has admitted that the inner lid 3 of *Hiroshi* is inherently flexible, and such flexibility is required to compensate for pressure build-up on the inside of the can caused by high-temperature and high-pressure in the sterilization process. Office Action 8/16/2005, at 4.

Thus, due to the inherently flexible nature of the inner lid 3 and build-up of pressure during the sterilization process, the inner lid 3 would assume a convex shape as the increased interior gas pressure pushes the interior lid 3 toward the exterior lid 5.

Appellant's claim with regard to its invention, that the "laminar member is spaced from the flexible membrane by a distance less than the maximum possible extension of the flexible membrane towards the laminar member." See, Claim 1, Claims Appendix. If *Hiroshi* were modified so that the outer lid 5 was spaced apart from the inner lid 3 by a distance less than the maximum possible extension of the inner lid 3 towards the outer lid 5, the effect of reducing the distance that exists between the outer lid 5 and the inner lid 3 would cause the inner lid to flex into a convex shape during the sterilization process, thereby contacting the underside of the outer lid 5. Should this happen, there is the distinct possibility that the plastic sheet would rupture due to the existence of the vent holes 8. The vent holes 8 permit the convex plastic sheet to extend beyond the surface of the underside of the outer lid 5, resulting in an uneven distribution of pressure on the inner lid. This uneven distribution of pressure may cause the inner lid 3 to burst, thereby causing the contents of the container to spoil.⁷ Thus, the function of the sealed container, to preserve food until such time as one desires to consume it, is rendered useless if modified by the inventive limitation disclosed by the present invention.

As expressed in *Gordon*, because the proposed modification of the prior art renders that prior art useless, the prior art does not teach or suggest the modification

⁷ Another distinct possibility is the inner lid 3 extends through the vent holes 8 during sterilization and remains there after heating.

embodied in the present invention. 733 F.2d at 902, 221 USPQ 1127. Consequently, without teaching or suggestion for the modification, there is no expectation of success. Finally, because there is no teaching or suggestion for the modification of the prior art, the prior art cannot in itself disclose all elements of the claimed invention. Therefore, rejection pursuant to 35 U.S.C. § 103(a) is improper, and Appellant respectfully requests that the rejection be reversed and a Notice of Allowance be issued.

C. Rejection of Claims 1, 3, 4, 6, 8 -11, and 13 pursuant to 35 U.S.C. § 112 ¶ 1.⁸

Examiner rejected claims 1, 3, 4, 6, 8-11, and 13 pursuant to 35 U.S.C. § 112 ¶ 1 on the basis that the specification failed to satisfy the written description requirement. The Office conceded that the rigid cap was disclosed with an annular skirt and deformable annular sealing ring, but asserted that the specification failed to disclose a

⁸ As has been stated *supra*, it is unclear from the prosecution history whether claims 1, 3, 4, 6, 8-11, and 13 continue to be rejected pursuant to 35 U.S.C. § 112 ¶¶ 1 and 2 because (i) there was never an acknowledgment that the rejection had been overcome; and (ii) the Examiner has maintained the related objection to the drawings under 37 C.F.R. § 1.83(a). Initially, the Office rejected these claims pursuant to both paragraphs of section 112 in its Office Action dated December 16, 2004, to which Appellant responded and traversed such rejections in its response dated March 16, 2004. The Office's subsequent Office Action, made final, failed to again express such rejections, contrary to the requirements of MPEP 707.07(e) and 37 C.F.R. 1.113(b) ("In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof."), but curiously continued to assert an objection to the drawings, which is directly related to the section 112 rejections. Therefore, it appears that such rejections have not been traversed, and Appellant addresses them on appeal. In the event that the rejections have been traversed, Appellant asserts that the continued objection to the drawings is improper and should be withdrawn. While generally such objection is presented by petition and reconsidered by the Director, in the present case appeal to the Board is appropriate because it is involved in the rejection of a claim. See 37 C.F.R. 1.113(a) ("Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim(§1.181)). In other words, the objection to the drawings (i) involves a rejected claims; and (ii) is directly related to the §112, ¶1 rejection.

laminar member of the rigid cap from which the annular skirt depends. *See* Office Action 12/16/2004, at 4. Related to this rejection, the Office objected to the drawings pursuant to 37 C.F.R. 1.83(a) for failing to disclose “the laminar member of the closure in addition to the annular sealing ring.” *Id.* at 2.

The written description requirement considers “whether the subject matter of a claim is supported by [conforms to] the disclosure of an application as filed.” MPEP § 2163.01. Compliance with the written description requirement is determined by an objective standard, considering whether “the description clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” MPEP § 2163.02 (quotation removed). Possession is demonstrated through description of all limitations through words and figures. *Id.* (citing *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997)).

Here, the Office rejected the claims based on the alleged failure to disclose the “laminar member” of claim 1 subpart (v) in the specification. Appellant amended the specification clarifying that the laminar member comprised a circular disc in the preferred embodiment, the circular disc previously identified as reference (21) in Figure 1, such that the “laminar member” is now reference (21). *See* Amendment 03/16/2005, at 3-4. As written and amended, the specification adequately conveys to one skilled in the art the substance of the laminar member, to wit it is a circular disc. Through reference to Figures 1 and 2 which show the laminar member’s location in the rigid cap, the nature of the laminar member is apparent.

Further, one of ordinary skill in the art would understand that the term “laminar,” when used in conjunction with the term “member” and referenced at (21) of Figure 1, is intended as an adjective derived from “lamina.” The dictionary definition, i.e. the common, ordinary, every-day meaning of “lamina” is “a thin plate or layer.” *See*, Webster’s II NEW RIVERSIDE DICTIONARY Revised Edition (1996). The dictionary also clearly indicates that “laminar” is an adjective of “lamina.” *Id.* The Examiner stated in the January 9, 2006 Advisory Action that Appellant’s arguments

“raise new issues for consideration in light of applicant being his own lexicographer and uses the term ‘laminar’ inconsistent with its typical usage and does not set forth his intent in the specification.”

Contrary to the Examiner’s statement, one of ordinary skill in the art, in this case food processing and storage, would certainly recognize that the “laminar member” reference is a member that is a thin plate, as is generally the case for container tops that are fastened with a twist fastening mechanism. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (holding person of ordinary skill in the art reads a claim term in context of the claim and the specification).

Further, if Appellant has acted as its own lexicographer, he has done so through the implicit definition of “laminar.” Appropriate lexicography is not confined to explicit definition of a term in the specification; an applicant can employ a specific definition by implication as evidenced by “usage of the term in the context of the specification.” MPEP § 2111.01 (III) (*citing Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)). In the instant application, Appellant defines “laminar” by implication

in the Figures and the specification. At paragraph 0045, as amended, Appellant refers to the laminar member as a circular disc from which an annular skirt depends downwardly therefrom, effectively describing the rigid cap to the container. In the specific embodiment illustrated in Figure 1 and described in detail at paragraphs 0045 through 0046, as amended, the laminar member corresponds to the circular disc 21 and the annular skirt corresponds to annular skirt 22. Figure 1 shows that the circular disc 21 has a flat thin section and thus comprises a “lamina” and is contiguous with skirt 22. Further, Figure 1 and the accompanying description demonstrate that the disc and skirt are of the same material. Nowhere in the specification does it imply that the “laminar member” consists of a plurality of layers. If disc 21 did comprise a plurality of layers, skirt 22 would also require the same layering. In such context, use of “laminar” as describing a “thin” member is clear to one of ordinary skill in the art, and an explicit definition in the specification is not required.

Because sufficient definition is provided in context through the specification and the drawings, because one skilled in the art would appreciate the meaning of “laminar member,” and because the plain, ordinary, every day meaning of “lamina” is a thin plate and “laminar” is an adjective of “lamina” the objection is inappropriate. For the foregoing reasons Appellant believes that the Examiner’s rejections and objections were erroneous, and reversal of her decisions is respectfully requested. Appellant specifically requests that the objection under §1.83(a) be withdrawn and the rejection pursuant to 35 U.S.C. § 112 ¶ 1 be reversed, and a Notice of Allowance be issued.

D. *Rejection of Claims 1, 3, 4, 6, 8 -11, and 13 pursuant to 35 U.S.C. § 112 ¶ 2.*

Examiner further rejected claims 1, 3, 4, 6, 8-11, and 13 pursuant to 35 U.S.C. § 112 ¶ 2 on the basis that the claims were indefinite. “The test for definiteness . . . is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Id.* (quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)).

Appellant amended the claims and specification in its amendment dated March 16, 2005. Specifically, Appellant amended the preamble of claim 1 to clarify that the container assembly claimed includes the open-end closure as well as the open-ended container; that in Claim 1 subpart (ii) the seal is an adhesive seal and thus a structural element; and through amendment of the specification clarification of the location of the laminar member was made. The Office provided no further rejection or guidance regarding whether the claim language was still indefinite. In further light of the argument supporting adequate definition of “laminar member,” *supra*, the rejections pursuant to 35 U.S.C. § 112 ¶ 2 are erroneous, and Appellant requests reversal of the rejection and issuance of a Notice of Allowance.

(8) CONCLUSION

Pending claims 1, 2, 4, 6, 8-11, and 13 remain rejected pursuant to 35 U.S.C. §§ 103(a); 112 ¶ 1; and 112 ¶ 2, and claims 14-22 have been withdrawn from consideration. Appellant respectfully asserts that the Examiner has not established the existence of a *prima facie* case of obviousness, that the written description requirement is satisfied, that the claims are sufficiently definite, and that the drawings fully disclose each and every limitation of Appellant's claimed invention. Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's decisions on all counts.

This Appeal Brief is being submitted within the time period specified in 37 C.F.R. §41.37(a)(1). The Commissioner is hereby authorized to charge fees specified in §41.20(b)(2) and other additional fees, if necessary, and to credit any such fees or overpayment to Deposit Account No. 50-1901 (Reference – 350013-000065).

Respectfully submitted,

By 

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(A) CLAIMS APPENDIX

1. (Previously Presented) A container assembly comprising a closure for an open-ended container, and an open-ended container, the container assembly comprising:

- (i) a flexible membrane for closing the open end of the container;
- (ii) an adhesive seal between the flexible membrane and the container;
- (iii) a rigid cap having a resiliently deformable member juxtaposed to the flexible membrane such that when the cap is in use, the flexible membrane is pressed against the container in the vicinity of the seal, thereby reinforcing the seal sufficiently to withstand high pressures which are generated from cooking the contents of the container;

- (iv) the rigid cap further having a first cam and follower pair, which when in use is engaged with a second cam and follower pair located on the container neck, relative movement between the first and second cam and follower pairs in a predetermined direction causes the rigid cap and the container neck to approach one another, thereby increasing the pressure exerted by the resiliently deformable member on the flexible membrane; and

- (v) the rigid cap further having a laminar member and an annular skirt, the skirt extending downwardly from the laminar member, and the second cam and follower pair is secured on an upper wall of the skirt,

wherein the laminar member is spaced from the flexible membrane by a distance less than the maximum possible extension of the flexible membrane towards the laminar member.

2. (Cancelled)

3. (Previously Presented) A container assembly according to Claim 1 wherein the first and second cam and follower pairs include co-operating screw threads formed respectively on the container neck and the rigid cap.

4. (Previously Presented) A container assembly according to Claim 1 further having an annular flange, the resiliently deformable member is substantially congruent with the flange, and wherein the rigid cap is in place over the container, the resiliently deformable member presses the flexible membrane against the flange.

5. (Cancelled)

6. (Previously Presented) A container assembly according the Claim 1 wherein the laminar member is a circular disc, and the skirt extends from the outer periphery thereof.

7. (Cancelled)

8. (Previously Presented) A container assembly according to Claim 1 wherein the resiliently deformable member comprises a foamed material secured to the rigid cap.

9. (Previously Presented) A container assembly according to Claim 1 wherein the flexible membrane comprises a metal foil adhesively securable on the container neck.

10. (Previously Presented) A container assembly according to Claim 4 wherein the rigid cap is shaped for use with the container neck which is generally cylindrical in shape.

11. (Previously Presented) A container assembly according to Claim 1 including a lifting tab hingedly secured to the flexible membrane and is comprised of the same material as that of the flexible membrane.

12. (Cancelled)

13. (Previously Presented) A container assembly according to Claim 1 wherein the rigid cap supports the body of the can in a radial direction.

14. (Withdrawn) A method of closing a container with a closure to form a container assembly according to Claim 1 comprising the steps of:

(i) adhesively securing said flexible membrane on the open end of the neck of the container, thereby forming said seal;

(ii) engaging the cam and follower of a said rigid cap and the container neck, with one another; and

(iii) moving the rigid cap and the container neck relative to one another to cause relative movement between the cam and the follower in the predetermined direction, thereby causing the resiliently deformable member to press the flexible membrane against the container in the vicinity of the seal sufficiently to maintain the seal against pressures generated in the container on cooking of its contents.

15. (Withdrawn) A method according to Claim 14 including the step of securing the flexible membrane on the open end of the said container neck by use of a heat-sealing method such as heat contact, ultrasonic, induction or hot air heating.

16. (Withdrawn) A method according to Claim 14 wherein the step of moving the rigid cap and the container neck relative to one another includes rotating the rigid cap and the container relative to one another.

17. (Withdrawn) A method according to Claim 14 wherein the step of adhesively securing the flexible membrane on the open end of the container neck includes the sub steps of applying adhesive material to the flexible membrane and/or the container neck; engaging the flexible membrane and the container neck with one another to define the seal; and curing the adhesive material.

18. (Withdrawn) A method according to Claim 17 wherein the substep of curing the adhesive material includes heating thereof.

19-21. (Cancelled)

22. (Withdrawn) A method according to Claim 14 including the steps of:

Adding food to the container through a second open end of the container which is opposite said open end closed by said closure;

closing said second open end by a conventional can end;

heating said food within said container to cook said food; and

preventing rupture of said flexible membrane due to internal container pressure caused by said heating by the presence of said laminar member of said cap.

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(B) EVIDENCE APPENDIX

None

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(C) RELATED PROCEEDINGS APPENDIX

None

